

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1619
	)	
CLASSEN, John Barthelow	)	Examiner: FOLEY, S.
	)	
Serial No.: 08/591,651	)	Washington, D.C.
	)	
Filed: February 12, 1996	)	July 1, 2009
	)	
For: METHOD AND COMPOSITION	)	Docket No.: CLASSEN=1A
FOR AN EARLY VACCINE TO	)	
PROTECT AGAINST BOTH...	)	Confirmation No.: 9417

PETITION UNDER 37 CFR 1.181 FOR SUPERVISORY REVIEW

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

S i r :

The non-final action mailed April 20, 2009 refuses to enter and consider (1) the "Declaration (II) of Dr. Bart Classen with 19 attached exhibits filed October 8, 2002<sup>1</sup>, and (2) the Third IDS with references KA-KC filed December 12, 2002<sup>2</sup>. The basis set forth for the refusal to enter was that entry of papers (1) and (2) was denied twice, in the petition decision of February 6 and July 16, 2003. As we will explain in more detail below, the basis for these petition decisions was 37 CFR 1.195, which applies to after appeal papers, and hence their rationale no longer applied after the PTO reopened prosecution on June 18, 2004. See MPEP 1207.04.

Consequently, Applicants petition the Commissioner to exercise supervisory authority and direct the Examiner to issue a supplemental action which (1) enters and considers the aforementioned declaration and IDS, and (2) resets the period for response. Alternatively, the present action can be vacated and the examiner directed to enter and consider the declaration and IDS, and prepare a new action.

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<sup>1</sup> The Examiner erroneously refers to "20 declarations".

<sup>2</sup> These references KA-KC had been among the exhibits filed October 8, 2002.

Background

Applicant filed his first Appeal Brief on May 1, 2000. In response, the PTO withdrew finality. A new final rejection was made on November 5, 2001. The first after final amendment was filed February 21, 2002 (and later refused entry).

Applicants filed a new notice of appeal on May 6, 2002, and the aforementioned Declaration on October 18, 2002. On November 5, 2002, Applicants filed a second Appeal Brief. The Appeal Brief relied on the declaration.

On November 8, 2002, the Examiner refused to enter the October 18, 2002 declaration, citing 37 CFR 1.97(e) and 1.116.

On December 12, 2002, Applicant filed a petition for supervisory review under 37 CFR 1.181, including a conditional petition to waive the rules under 37 CFR 1.183. The Third IDS was also filed. The 1.181 petition argued that 1.97(e) was inapplicable, and presented a showing under 1.116/1.195<sup>3</sup>.

On February 6, 2003, the Director denied the 1.181 petition. The Director agreed that 1.97(e) was inapplicable, but held

- (i) 37 CFR 1.195 applied,
- (ii) with regard to those items which were available prior to the final rejection, such items should have been referenced in the first response to the final rejection,
- (iii) with regard to those items which became available after the final rejection, they were unlikely to add evidence of sufficient weight to cure the deficiencies of the previous presentations,
- (iv) hence, applicant's reasons for entry and consideration did not rise to the level of "good and sufficient cause" as required by 1.195.

Applicant was also advised that the petition under 1.183 would need to be presented as a separate paper.

On March 5, 2003, Applicant filed (1) a request for reconsideration and modification of the February 6, 2003 petition

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<sup>3</sup> The Director later agreed with Applicant that 1.195, rather than 1.116, was controlling.

decision and (2) a petition under 1.183 to waive the rules. The request for reconsideration was directed to the five items published only after the final rejection, see point (iii) above.

On July 16, 2003, the Director denied the renewed petition under 1.181. The Director conceded that the post-filing date evidence cited could be relevant, see point (iii), but ruled that even the item published March 2002 was still not timely submitted. Again, the issue of timeliness was relevant only because of the applicability of 37 CFR 1.195.

To date, there has been no decision on applicant's March 5, 2003 petition under 37 CFR 1.183 to waive the rules.

On August 8, 2003, Applicant filed a corrected Appellant's Brief, omitting reference to the declaration.

On June 18, 2004 the PTO vacated the action of November 5, 2001 and reopened prosecution, commenting that "this application is still not ripe for appeal".

The April 20, 2009 non-final action complained-of is the first action on the merits since prosecution was reopened almost five years earlier.

#### Argument

1. The sole legal basis for refusing to enter and consider the Declaration of October 18, 2002 was that it was filed after appeal and Applicants allegedly did not comply with 37 CFR 1.195 by showing "good and sufficient cause" why it was necessary and not earlier presented.

MPEP 1207.04 says that if prosecution is reopened by the examiner after the brief has been filed,

Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits. (emphasis added)

Hence, the Declaration of October 18, 2002 should have been entered as of right when prosecution was reopened in 2004.

2. The Examiner mistakenly states that the petition decision refused to enter the IDS of December 12, 2002.

Obviously, it was not refused entry by the November 18, 2002 advisory action. The IDS was filed to make a 1.97(e) certification nunc pro tunc (i.e., as of the time of the original disclosure of the references, the October 18, 2002 declaration date) as explained on page 5 of our December 12, 2002 petition, and see also section 6 of Third IDS. Nonetheless, there is no reference to this IDS in the February 6, 2003 petition decision. Likewise, there is no reference to the IDS in the July 16, 2003 petition decision. The instant action is in fact the first paper from the PTO to address entry of the IDS. The IDS cites three references, whereas the Declaration cited nineteen.

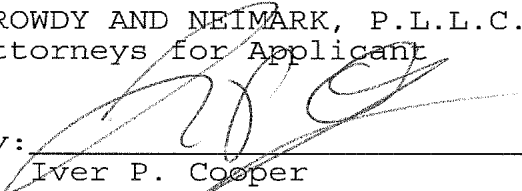
In any event, the Third IDS should have been entered as a matter of right after prosecution was reopened, under MPEP 1207.04 and 1.97(c)(2). If the nunc pro tunc 1.97(e) certification were deemed improper, entry of the IDS would nonetheless be proper now, when the case is in a non-final posture, under 1.97(c)(1) if the fee is paid. Note the deposit account authorization in section 8 of the Third IDS, which would be triggered if the 1.97(e) certification were not accepted.

3. Applicant believes that the fees paid for his petition under 1.183 should be refunded because the PTO has failed to rule on its March 5, 2003 1.183 petition, in spite of the fact that over six years have elapsed since it was filed.

If a refund is possible under these circumstances, Applicant withdraws the 1.183 petition.

Respectfully submitted,

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